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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/669,474 Confirmation No. : 4831
Applicant : DOUGLAS G. McNEEL, *et al.*
Filed : September 25, 2003

Docket No. : 011335.52703US
Customer No. : 23911

Title : METHODS AND COMPOSITIONS FOR TREATING
PROSTATE CANCER USING DNA VACCINES

Commissioner for Patents
P.O. Box 1450
Alexandria , VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication timely responds to the Office Action dated October 19, 2004.

The Office Action states that the pending claims 1-32 belong to four allegedly independent and distinct groups of inventions. In response, applicants elect, with traverse, Group 1, Claims 1-9, 23-25, 28-30 and 32.

Applicants respectfully traverse the restriction between Groups I and II because the Office Action failed to show that they are distinct or independent. Applicants respectfully submit that Claim 10 is not distinct or independent from Claim 1 because Claim 1 recites a method of administering "PAP polynucleotides" to a mammal, and Claim 10 similarly recites a method of administering a "PAP polypeptides" to a mammal, except that the "PAP polynucleotides" are from two different species. Thus, Claim 10 falls within the scope of Claim 1, and can be re-drafted into a dependent claim depending from Claim 1. Thus these are not patentably distinct inventions, but are related inventions. The Office Action conclusorily stated that because Group II claims require "PAP polynucleotides" from a different species, it is patentably distinct from Group I claims. The Office Action, however,

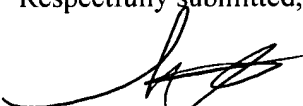
fails to explain on what legal basis was the conclusion made. Applicants respectfully submit that the Office Action failed to establish a *prima facie* case for restriction, because the claims belong to the same classification in the art, and have the same filed of search. When "the classification is the same and the filed of search is the same ... no reason exists for dividing related inventions." MPEP § 808.02. Accordingly, applicants respectfully submit that the restriction between Groups I and II is improper and should be withdrawn.

Because Groups I & II and III & VI are related to each other as product and process for using the product, applicants note that the rejoinder practice under MPEP § 821.04.

Applicants now await an Office Action on the merits. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Respectfully submitted,

November 18, 2004



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